

## REMARKS

Claims 1-14 and 22-24 are pending in this application, with dependent claim 24 having been added herein. Claims 15-21 were previously withdrawn from consideration. Claims 1, 4, 8, 13-14, and 23 have been amended and claims 2 and 22 have been cancelled. Amended claim 1 finds support in original claims 1 and 2, and claim 8 is amended to correct its dependency in view of the cancellation of claim 2. Dependent claim 24 finds support in original claim 13. Accordingly, no new matter has been added, and the entry of these amendments is respectfully requested.


### **I. Objection to Claims 4, 14, and 23**


The Examiner objected to claims 4, 14, and 23 "because the claims contain recitation of cyclosporins with non-elected  $R_1$ ,  $R_2$ ,  $R_4$  to  $R_{11}$ , and  $Z_1$ ,  $Z_2$ , and  $Z_4$ - $Z_{11}$  groups." In the Response to the Restriction Requirement, Applicant elected the compound of Example 1, [(R)-2-(N,N-dimethylamino)ethylthio-Sar]<sup>3</sup>-[4'-hydroxy-MeLeu]<sup>4</sup>-cyclosporin A. This corresponds to a compound of claim 4 wherein the substituents are as defined in group ii. That is, the radicals  $R_1$ ,  $R_2$ , and  $R_4$  to  $R_{11}$ , and  $Z_1$ ,  $Z_2$ , and  $Z_4$  to  $Z_{11}$  are defined as for cyclosporin A, with the exception of  $R_4$  and  $Z_4$ , which are defined so as to have, at the 4-position, the amino acid 4'-hydroxy-methylleucine. Applicant's amendments presented herein to claims 4, 14, and 23 reflect this election. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to claims 4, 14, and 23.

**II. Rejection under 35 U.S.C. § 112, ¶ 2**

The Examiner rejected claims 1-14 and 22 under 35 U.S.C. § 112, ¶ 2, because the term "cyclosporin derivative" is allegedly indefinite. Specifically, the Examiner reasoned that "it is not clear how different the derivative is from its parent compound, and what structure the derivative has." Claims 2-12, 14, and 22 were included in the rejection because they depend from rejected claim 1. Applicant respectfully traverses this rejection, and directs the Examiner's attention to page 1 of the specification, where Applicant has defined "cyclosporin derivative" as "synthetic cyclosporins." These cyclosporins are distinct from "natural cyclosporins," which Applicant also defined on page 1 of the specification as "cyclosporins." Accordingly, in light of the specification, the term "cyclosporin derivative" is not indefinite and Applicant respectfully requests that the Examiner withdraw this rejection as improper.

The Examiner rejected claim 3 as indefinite because it is allegedly "not clear what the formula (I) represents." Applicant respectfully traverses this rejection and

submits that the skilled artisan would understand that  of formula (I) is art-recognized shorthand for a cyclosporin and its customary substituents. The claim provides further explanation for the structure of formula (I) by stating that

 is "a cyclosporin in which one or more hydroxyl groups and optionally one or more non-methylated nitrogen atoms at the  $\alpha$  position and optionally any other deprotonatable acidic group are optionally deprotonated or in the protected form."

Formula (I) of claim 3, therefore, is not indefinite and Applicant respectfully requests that the Examiner withdraw this rejection as improper.

The Examiner rejected claims 13 and 14 because the terms "if any" or "which may possibly interfere" allegedly render the claims indefinite, as, according to the Examiner, "it is not clear whether the limitation following the term is part of the claim." Claim 14 was included in the rejection because it depends from rejected claim 13. Applicant respectfully traverses this rejection. In an effort to expedite prosecution, Applicant has deleted this language from claim 13 and has added dependent claim 24, which finds support in original claim 13. Accordingly, this amendment obviates the Examiner's rejection and Applicant respectfully requests that the Examiner withdraw this rejection.

Lastly, the Examiner rejected claim 22 for failing to provide sufficient antecedent basis for the term " $R_1$  in formula (IIIb)." Applicant notes that claim 22 mistakenly depended from claim 1, instead of claim 4. Regardless, because Applicant's current amendment to claim 4 negates the possibility of formula (IIIb), Applicant has cancelled claim 22. Applicant, however, reserves the right to pursue the subject matter of claim 22 in a later continuing application. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

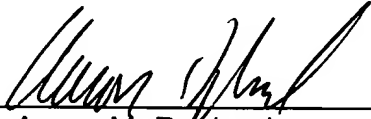
In view of these amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: December 14, 2005

By:   
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